REMARKS

Claim 1-14 are pending. By this Amendment, the abstract is amended and claims 1-4, 6, 8 and 13 are amended. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Claim 8 is objected to. Claim 8 has been amended to recite a method of manufacturing a device in at least one layer of a substrate. With respect to the term "the overlay errors," claim 8 as previously amended, and as currently written, recites determining an overlay error between the overlay mark formed in the resist layer and an overlay mark in the substrate, and adjusting the exposure system to correct the overlay error. Line 23 has been amended in accordance with the suggestion of the Office Action and line 24 has been amended to recite "the resist overlay mark."

Reconsideration and withdrawal of the objection to claim 8 are respectfully requested. Claims 1-14 were rejected under 35 U.S.C. §112, second paragraph.

The term "substantially larger" has been amended in accordance with the suggestion of the Office Action.

With respect to page 2, paragraph number 5 of the Office Action, the use of the terms p_1, p_2, p_s, p_r and p_b, in claims 1 and 8 was not intended as an indication of the size of the particular marks, as alleged in the Office Action. The use of terms was merely as labels for the various periods of the marks. Claims 1 and 8 have been amended to more clearly label the periods as first, second, third, fourth and fifth.

With respect to the rejection set forth on page 3, paragraph number 6, MPEP §2172.01 states: "A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. §112, first paragraph, as not enabling." (Emphasis added.) MPEP §2172.01 further states: "In addition, a claim which fails to interrelate the essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. §112, second paragraph for failure to point out and distinctly claim the invention." (Emphasis added.)

It is clear from MPEP §2172.01 that the determination of whether disclosed subject matter is essential is an objective test involving the determination of what subject matter applicants have disclosed or defined as essential, not a subjective test of what the Examiner considers to be essential. As Applicants have not disclosed or defined any of the structural

cooperative relationships identified on page 3, paragraph number 6, of the Office Action as essential, the rejection is improper and must be withdrawn.

With respect to the rejection on page 3, paragraph number 7, of the Office Action, claim 1 has been amended in accordance with the suggestion of the Office Action.

Reconsideration and withdrawal of the rejection of claims 1-14 under 35 U.S.C. §112, second paragraph are respectfully requested.

Claims 1-7 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-4, 6 and 8 of U.S. Patent Application 09/940,819. The rejection is respectfully traversed.

MPEP §804B.1. sets forth the requirement for establishing an obviousness-type double patenting rejection. As required by that section any obviousness-type double patenting rejection should make clear: (a) the difference between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and (b) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

As the Office Action fails to identify the differences between claims 1-7 of the instant application and claims 1-4, 6 and 8 of U.S. Patent Application 09/940,819, and also fails to provide any reasons why a person of ordinary skill in the art would conclude that the inventions defined in claims 1-7 are obvious variations of the inventions defined in claims 1-4, 6 and 8 of U.S. Patent Application 09/940,819, it is respectfully submitted that the rejection is improper and must be withdrawn.

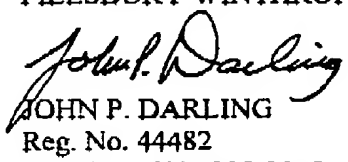
Reconsideration and withdrawal of the rejection claims 1-7 under the judicially created doctrine of obviousness-type patenting are respectfully requested.

In view of the above amendments and remarks, Applicants respectfully submit that all the claims are allowable and that the entire application is in condition for allowance.

MONSHOUWER et al. -- 09/940,818
Client/Matter: 081468-0313791

Should believe the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
PILLSBURY WINTHROP LLP



JOHN P. DARLING
Reg. No. 44482
Tel. No. (703) 905-2045
Fax No. (703) 905-2500

Date: March 1, 2005
P.O. Box 10500
McLean, VA 22102
(703) 905-2000